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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,510	09/18/2001	Matthew A. Hayduk	884.552US1	9786
21186	7590	12/14/2004	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			RAMAKRISHNAIAH, MELUR	
		ART UNIT	PAPER NUMBER	
		2643		

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/955,510	HAYDUK, MATTHEW A.	

Examiner	Art Unit	
Melur Ramakrishnaiah	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 August 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8-12, 13-15, 16-17, 20-22, 24, 25-26, are rejected under 35 U.S.C 102(b) as being anticipated by Rosen et al. (US PAT: 6,014,090, hereinafter Rosen).

Regarding claim 1, Rosen discloses an application execution system, comprising: a position monitoring module (132, fig. 1), a mobile element (130, fig. 1) associated with a position capable of being monitored by a position monitoring module (col. 2 lines 57-67, col. 3 lines 1-12), the mobile element having a memory including a set of user service preferences including a first service preference (col. 3 lines 57-61, col. 5 lines 59-67, col. 6 lines 1-4), a service broadcaster (reads on 110/120, fig. 1) capable of being communicatively coupled to the mobile element and broadcasting a second service preference to the mobile element and a comparator module communicatively coupled to the mobile element to compare the first and second service preferences (note: comparator is implicit in the sense that user of mobile receives only resource address of service preferences satisfying geographic location and user profile, col. 8 lines 56-59, col. 6 lines 5-33).

Regarding claim 13, Rosen discloses a mobile element, comprising: a position monitoring module (132, fig. 1) capable of monitoring a position associated with the mobile element (130, fig. 1, col. 2 lines 57-67, col. 3 lines 1-12), a first memory including

a first service preference, the memory capable of receiving a second service preference determined by the position (col. 3 lines 57-61, col. 5 lines 59-67, col. 6 lines 1-4), and a comparator module communicatively coupled to the memory to compare the first and second service preferences (note: comparator is implicit in the sense that user of mobile receives only resource address of service preferences satisfying geographic location and user profile, col. 8 lines 56-59, col. 6 lines 5-33).

Regarding claim 16, Rosen discloses a apparatus, comprising: a processor in (120, fig. 1), a memory (122, fig. 1) coupled to the processor for receiving a position and a first service preference associated with a mobile element (130, fig. 1), a memory coupled to the processor including a second service preference associated with the position (col. 3 lines 57-61, col. 5 lines 59-67, col. 6 lines 1-4,), and an application associated with the second service preference (col. 6 lines 5-33, col. 8 lines 56-59).

Regarding claim 20, Rosen discloses a method of executing an application, comprising: determining a position of a mobile element (130, fig. 1, col. 2 lines 57-67, col. 3 lines 1-12), and selecting a second service preference associated with the application according to the position and a first service preference (col. 5 lines 59-67, col. 6 lines 1-33, col. 8 lines 56-59).

Regarding claim 25, Rosen discloses a computer readable medium having program instructions stored thereon for implementing, when executed by a digital processing device, a method for executing an application, the method comprising: determining position of the a mobile element (130, fig. 1, col. 2 lines 57-67, col. 3 lines 1-12), selecting a second service preference associated with the application according

to position and a first service preference retained in the mobile element (col. 5 lines 59-67, col. 6 lines 1-33, col. 8 lines 56-59).

Regarding claims 2-6, 8-12, 14-15, 17, 21-22, 24, 26, Rosen further teaches the following: position-monitoring module includes a software program (this is implicit in as much as the reference teaches GPS receiver and GPS satellite system for specifying the geographic location of the mobile communication device: col. 3 lines 8-12), comparator module resides in the service broadcaster (note: comparator is implicit in the sense that user of mobile receives only resource address of service preferences satisfying geographic location and user profile, col. 8 lines 56-59, col. 6 lines 5-33), global positioning system receiver communicatively coupled to the position monitoring module (fig. 1 col. 3 lines 8-12), the mobile element includes a memory, and wherein the service broadcaster includes an application with the associated second service preference (col. 3 lines 57-61, col. 5 lines 59-67, col. 6 lines 1-4, col. 8 lines 56-59), application is downloaded to the memory when the first and second service preferences are determined to be related by the comparator module (note: comparator is implicit in the sense that user of mobile receives only resource address of service preferences satisfying geographic location and user profile, col. 8 lines 56-59, col. 6 lines 5-33), mobile element is a cellular telephone (col. 3 lines 42-47), second service preference is hotel list file (col. 5 lines 59-67, col. 6 lines 1-2), plurality of list files related to the set of user preferences is broadcast to the mobile element, plurality of list files is formatted as a selection list, selection list includes a selected number of items determined by the position (col. 5 lines 50-67, col. 6 lines 1-33), broadcasting the second service

preference to the mobile element, requesting the broadcast of the application, and broadcasting the application to the mobile element for downloading and execution by the mobile element (col. 6 lines 5-44), storing the first service preference in the mobile element (col. 5 lines 59-67, col. Lines 1-4), second service preference is a hotel list file (col. 5 lines 59-66).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen in view of Roundtree (US PAT: 6,640,098 filed 9-8-2000).

Regarding claim 7, Rosen does not teach the following: mobile element is a personal Internet client.

However, Roundtree discloses a system for obtaining service related information for local interactive wireless devices which teaches the following: mobile element is a personal Internet client (col. 5 lines 37-42).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Rosen's system to provide for the following: mobile element is a personal Internet client as this arrangement would facilitate accessing information from the internet, thus enhancing user choices for obtaining information.

5. Claims 18-19, 23, 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen in view of Bar et al. (US PAT: 6,456,852, filed 10-10-1997, hereinafter Bar) and Uchiumi (JP411073398A).

Regarding claims 18-19, 23, 27, Rosen does not teach the following: a memory for receiving a set of capabilities associated with the mobile element, application is not downloaded to the mobile element if the set of capabilities associated with the mobile element is not in accordance with a set of application requirements associated with the application, sending a set of capabilities associated with the mobile element to a service broadcaster, and refraining from broadcasting the application to the mobile element if the set of capabilities associated with the mobile element is not in accordance with a set of application requirements associated with the application.

However, Bar discloses internet distributed real time wireless location database which teaches the following: sending/broadcasting information to the user from a database depending upon the capability associated with a user device (fig. 1, col. 5 lines 42-65) and Uchiumi discloses distributed network computing system which teaches the following: determining application capabilities and providing an application service which corresponds to processing capability of each terminal (fig. 1, see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Rosen's system to provide for the following: a memory for receiving a set of capabilities associated with the mobile element, application is not downloaded to the mobile element if the set of capabilities associated with the mobile

element is not in accordance with a set of application requirements associated with the application, sending a set of capabilities associated with the mobile element to a service broadcaster, and refraining from broadcasting the application to the mobile element if the set of capabilities associated with the mobile element is not in accordance with a set of application requirements associated with the application a this arrangement would provide flexibility to the user for receiving information from a server in a form suitable for user device, thus providing versatility for obtaining information suitable for user needs.

Response to Arguments

Rejection of Claims 1-6, 8-12, 13-15, 16-17, 20-22, 24, 25-26, under 35 U.S.C 102(b) as being anticipated by Rosen et al. (US PAT: 6,014,090, hereinafter Rosen): regarding rejection of independent claims 1 and 13 using Rosen reference, Applicant argues that “it is respectfully noted that Risen does not discloses “a mobile element having a memory including a set of user service preferences”, as claimed by Applicant. First, no memory is shown or described with respect to Rosen’s mobile communication system130, 140”. Regarding this, contrary to applicant’s interpretation of the Rosen reference, Rosen not only teaches the user’s profile can be stored in memory 112 of resolution server 110 as acknowledged by the Applicant, but he also teaches processor (111, fig. 1) and memory (112, fig. 1) of resolution server are coupled to user interface device (133, fig. 1) located with the mobile communication system (130, fig. 1) rather than coupled through communication network (col. 3 lines 57-61). This clearly teaches a mobile element having a memory including a set of user service preferences because Rosen already teaches storing a set of user service preferences in memory (112, fig. 1,

col. 5 lines 59-67, col. 6 line 1) and further Rosen teaches that this memory can be coupled to mobile communication system as already explained. Therefore rejection of claims 1 and 13 is maintained.

Regarding rejection independent claims 16, 20, and 25, Applicant argues that "Rosen does not disclose "an application associated with the second service preference associated with the application" as claimed by the Applicant". Contrary to applicant's interpretation of the Rosen reference, Rosen clearly teaches mobile user profile can be predefined such as user's preferred facilities and services such as preferred hotels, gas stations, restaurants, etc and predefine specific services associated with a given facility such as services for a hotel room, smoking versus non smoking, king size bed versus two double bed, facsimile/computer capabilities in the room, and so on and profile can be stored in memory (col. 5 lines 59-67). Rosen also teaches obtaining this information from server (col. 6 lines 12-53). In order for the user to obtain information about these services, application programs are implicitly required to obtain these services. Therefore, application is associated with user service preference to obtain services desired by the user by accessing server associated with different services facilities (col. 6 lines 45-53). Since Rosen teaches claim limitations claims 16, 20, and 25 as discussed above, rejection of claims 16, 20, and 25 is maintained.

6. Rejection of claim 7 under 35 U.S.C 103(a) over Rosen in view of Roundtree (US PAT: 6,640,098 filed 9-8-2000): regarding rejection of claim 7, applicant puts forth arguments that there is no teaching or motivation to combine references. In response

to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Rosen does not teach mobile element which is a personal internet client. However, secondary reference Roundtree teaches this element (col. 5 lines 37-42). Therefore one of ordinary skill in the art at the time invention was made would be motivated to combine teachings of Roundtree with Rosen to obtain access to vast resources available from internet. In view of this, Examiner submits that *prima facie* case of obviousness has been established for claim 7 by combining Rosen with Roundtree because the combination teaches the limitation of claim 7.

Applicant's arguments with respect to rejection of claims 18-19, 23 and 27 are moot in view of new rejection as set forth in the office action above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on M-F 6:30-4:00; every other F Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703)305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melur Ramakrishnaiah
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Art Unit 2643